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Customer Number

Patent
Case No.: 59010US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: FLANNIGAN, PAUL J.
Application No.: 10/719959 Confirmation No.: 3577
Filed: November 21, 2003
Title: RESPIRATORY FACEPIECE AND METHOD OF MAKING A FACEPIECE
USING SEPARATE MOLDS

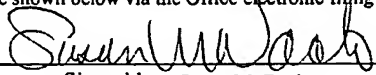
PETITION TO THE DIRECTOR UNDER 37 CFR § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being transmitted to United States Patent and Trademark Office on the date shown below via the Office electronic filing system.

July 11, 2008
Date


Signed by: Susan M. Dacko

Dear Sir:

This Petition is taken in response to the Final Office Action dated December 12, 2007.

Fees

- ☒ It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

I. STATEMENT OF FACTS

On December 12, 2007, the Examiner finally rejected applicants' pending claims 1-34. In addition to making prior art rejections, the Examiner objected to applicants' specification under 35 USC § 132(a) for introducing new matter into the specification. As originally filed, applicants' specification included the following definition for "fluid communication component":

"fluid communication component" means an element that is structured to allow a fluid to pass from an interior gas space to an exterior gas space or vice versa;

Applicants later amended this definition to read as follows (see June 5, 2007 Amendment), where the underlined text is the newly-introduced language:

"fluid communication component" means an element that is not part of a filter cartridge and that is structured to allow a fluid to pass from an interior gas space to an exterior gas space or vice versa;

The Examiner presently holds that the following bolded language in the definition constitutes new matter:

"fluid communication component" means an element **that is not part of a filter cartridge** and that is structured to allow a fluid to pass from an interior gas space to an exterior gas space or vice versa;

Applicants have taken issue with the Examiner's conclusion that the bolded language is new matter.

II. POINTS TO BE REVIEWED

Applicants request that the Director rule on the issue of whether the bolded language presented above constitutes new matter.

III. ACTION REQUESTED

Applicants request that the Director reverse the Examiner's position that the above-noted bolded text is new matter and instruct the Examiner to withdraw this rejection.

IV. MEMORANDA IN SUPPORT OF APPLICANTS' POSITION

In 1836 the Supreme Court first noted that the right to alter a patent application did not include the right to introduce "a distinct and different invention" "not contemplated by the specification, as submitted at the outset."¹ In 1952 Congress codified this rule with the enactment of 35 USC § 132. Title 35, Section 132, of the United States Code provides that "[n]o amendment shall introduce new matter into the disclosure of the invention." In considering this statutory provision, the reviewing authorities have made a number of interpretations. In particular, the reviewing authorities have indicated that an amendment to the specification does not violate the new matter rule if it merely "clarifies or completes" the original disclosure.² Thus, the specification and drawings may be amended to conform to one another.³ Further, the Court

¹ *Godfrey v. Eames*, 68 US 317, 325 (1864)

² *Tektronix Inc. v. The United States*, 445 F.2d 323, 326-27, 165 USPQ 392, 394 (Ct. cl. 1971), *appeal after remand*, 575 F.2d 832, 198 USPQ 378 (Court of Claims 1978), cert denied, 439 US 1048 (1978) ("In essence, what the applicant did was amend the drawing and specification in response to queries by the patent examiner, and thereby simply made explicit a disclosure which was implicit in the application as filed."); *Helms Products v. Lakeshore Manufacturing Company*, 227 F.2d 677, 679, 107 USPQ 313, 314 (7th Circuit 1955) ("Amendments to the specification for the purpose of clarity and definiteness are permissible.").

³ *In re Heinle*, 342 F.2d 1001, 1007, 145 USPQ 131, (CCPA 1965).

of Customs and Patent Appeals, the predecessor to the Federal Circuit, has stated that "the amendments to the specification merely render explicit what had been implicitly disclosed originally, and, while new language has certainly been added, we are not prone to view all 'language' ipso facto as 'new matter'".⁴ Thus, while new language that has been added to the specification often is, as stated, 'new' the new language is not necessarily 'new matter', prohibited by 35 USC § 132.⁵ On a number of occasions, the reviewing courts have indicated that an applicant's invention disclosure includes both the drawings submitted with the application on filing and the claims and the specification. The Courts have accordingly found that there is no "new matter" bar to amendments that make the specification conform to the subject matter disclosed in the original drawings and claims or vice versa. As noted in *Tectronix Inc v. the United States*, an applicant can, by amendment, make "explicit a disclosure which was implicit in the application as filed."

The language contested in this patent application, which specifies that the fluid communication component is not an element that is "part of a filter cartridge" does find support in the application as filed, albeit not explicit. That is, the applicant's original specification, did not explicitly use the words that the fluid communication component was "not part of a filter cartridge". Nonetheless, support for this amendment can be found in Figures 1 and 2 of the specification and in applicants' specification at page 5, lines 16 to page 6, line 23. In these two paragraphs, fluid communication components 30 and 32 are identified. These fluid communication components are shown as being parts that are attached to the face piece insert 16:

⁴ *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965).

⁵ *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971) ("In a sense, anything inserted in a specification that was not there before is new to the specification but that does not necessarily mean it is prohibited 'new matter.'").

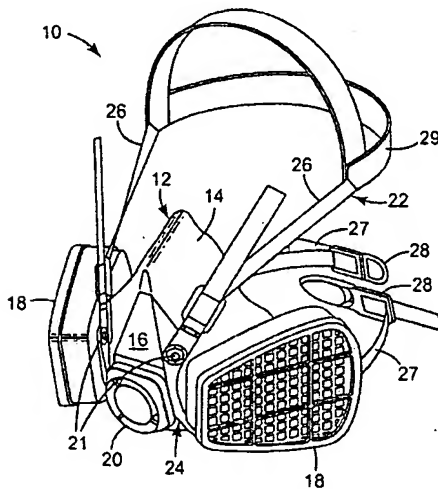


FIG. 1

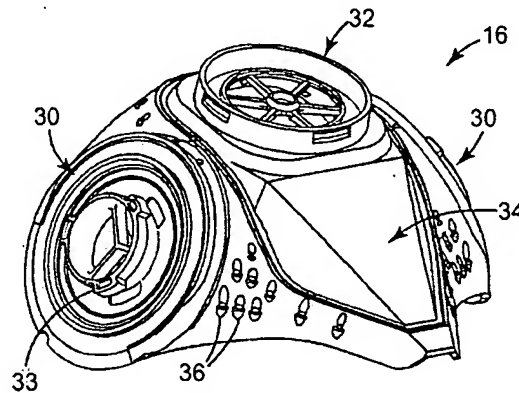


FIG. 2

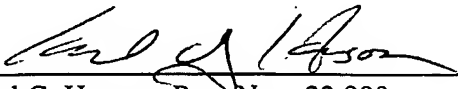
The filter cartridge 18 also is shown and described as being a part that is separate from the face piece insert 16 and that becomes attached to each of the fluid communication components 30 and 32. Further, in the paragraph that begins at line 25 of page 5, applicants specifically state that the intake "fluid communication component 30 has a bayonet structure 33 that enables a filter cartridge 18...to be attached to the face piece insert 16." Thus, it is clear that the fluid communication component 30 is not part of a filter cartridge.

Accordingly, applicants' amendment to the definition of fluid communication component has only made explicit what has been otherwise already disclosed in the specification and drawings as filed. For this reason, applicants submit that the objection to the modified definition for "fluid communication component" is not a modification that would constitute new matter under the terms of 35 USC § 132. Accordingly, applicants request that the Commissioner respectfully grant this petition.

This Petition is being filed within two months of the issuance of the Examiner's Answer dated May 15, 2008. In this document, the Examiner refused to enter a rejection pertaining to new matter, which would have given the Board jurisdiction over this issue. The Examiner accordingly instructed applicants to file a petition to the Commissioner.

Respectfully submitted,

July 11, 2008
Date

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